

#### **REMARKS/ARGUMENTS**

Claims 2-37 stand rejected. Claim 1 has previously been canceled without prejudice. In this paper, claims 5, 16, and 29 have been canceled, and claims 2-4, 6, 10, 11, 14, 15, 17, 24, 27, 28, 30, and 37 have been amended.

Applicants believe the amendments made herein add no new matter. Any amendment to the claims which has been made in this Amendment and Response, and which has not been specifically noted to overcome a rejection based on prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to be attached thereto. Reconsideration and reexamination of the application is respectfully requested in view of the amendments and the following remarks.

#### **Objection to Claims**

Claims 37 and 2-10 stand objected to as allegedly suffering from informalities. The objection is traversed.

Claim 37 has been amended to change the phrase "In a vehicular mirror assembly" to the phrase "A vehicular mirror assembly." Applicants request withdrawal of the objection.

Claim 4 has been amended to change the phrase "formed with the to the at least one of" to the phrase "formed with the at least one of." Applicants request withdrawal of the objection.

Claim 10 has been amended to change the phrase "polyester, an ABS plastic" to the phrase "polyester, and ABS plastic." Applicants request withdrawal of the objection.

**Rejection Under 35 U.S.C. §112, ¶2**

Claims 37 and 2-10 stand rejected under 35 U.S.C. §112, ¶2, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is traversed.

The Examiner asserts that it is unclear in claim 37 what is being connected together by the connector. "It appears that Applicant is attempting to claim two distinct connections and accordingly the scope of the claim is unclear. For purposes of examination Examiner has taken the connector to be joining the mounting frame to the mirror shell or the tilt actuator to the mounting frame.

Claim 5 has been canceled without prejudice. Thus, the rejection is moot as to claim 5. Applicants request of the withdrawal of the rejection of claim 5.

Claim 37 has been amended to clearly call for the connector to join at least one of the mounting frame and the mirror shell, and the tilt actuator and the mounting frame. Applicants believe that the amendment resolves the alleged indefiniteness, and request withdrawal of the rejection and the allowance of claims 37 and 2-4 and 6-10.

**Rejection Under 35 U.S.C. §102(b)**

Claims 37, 2-4, and 10 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,712,329 to Ishigami et al. The rejection is traversed.

The claimed invention is not anticipated under §102 unless each and every element of the claimed invention is found in the prior art. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986). To anticipate, a single reference must teach each and every limitation of the claimed invention. *Eolas Technologies Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1335; 73 U.S.P.Q.2D (BNA) 1782 (Fed. Cir. 2005). The identical invention must be shown in as complete detail as is contained in the claim.

*Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (*Fed. Cir.* 1989). The rejection fails to satisfy these standards.

Ishigami '329 discloses a mirror 10 for a vehicle comprising a rear side visor rim 28A and a front side visor cover 28B, which are interconnectable by a connector comprising pairs of J-shaped nipping claws 38 in the visor rim 28A. The nipping claws 38 are adapted to resiliently engage a corresponding number of cantilevered projecting hooks 48 in the visor cover 28B. The projecting hooks 48 terminate at a free end in a rectilinear widened portion 50 which is adapted to engage the distal ends of the nipping claws 38. When the hooks 48 are inserted into engagement with the nipping hooks 38, the nipping hooks 38 resiliently deform, and the widened portions 50 retain the projecting hooks 48 into engagement with the nipping claws 38. As a result, the visor cover 28B is held to the visor rim 28A.

Claim 37 has been amended, and now calls for a vehicular mirror assembly comprising a mounting frame, a mirror shell, a reflective element, a tilt actuator, and at least one connector. The mounting frame is adapted to be coupled to a vehicle. The mirror shell is mounted to the mounting frame and comprises a rearwardly-facing opening. The reflective element is mounted within the mirror shell in register with the rearwardly-facing opening. The tilt actuator is mounted to the mounting frame and the reflective element, for tiltably actuating the reflective element. The at least one connector joins at least one of (1) the mounting frame and the mirror shell, and (2) the tilt actuator and the mounting frame. The at least one connector comprises a neck portion having a second diameter, transitioning to a bulb end portion having a first diameter greater than the second diameter, and an aperture having a diameter greater than the second diameter and smaller than the first diameter, to provide a columnar snap-fit connection which securely retains the at least one of (1) the mounting frame to the mirror shell, and (2) the tilt actuator to the mounting frame.

Claim 37 is patentable over Ishigami '329. Ishigami '329 does not disclose a connector having a neck portion transitioning to a bulb end portion wherein the bulb end portion has a first diameter greater than the second diameter, or an aperture having a diameter greater than the second diameter and smaller than the first diameter, which together provide a columnar snap-fit connection. Claim 37 calls for the neck portion and the bulb end portion to have diameters, which indicate that the neck portion and the bulb end portion are characterized by circularity.

Ishigami '329, on the other hand, discloses nipping claws 38 and projecting hooks 48, which do not constitute a bulb end portion or a neck portion characterized by circularity. The projecting hooks 48, in particular, are rectilinear, i.e. without circularity. Furthermore, the nipping claws and projecting hooks of Ishigami '329 do not join the mounting frame to the mirror shell, or the tilt actuator to the mounting frame. Rather, the nipping claws and projecting hooks join 2 halves of a housing. Thus, Ishigami '329 does not teach each and every limitation of the invention of claim 37 in as complete detail as is contained in claim 37. Claim 37 is patentable over Ishigami '329.

Since claims 2-4 and 10 depend from claim 37, they are for the same reasons patentable over Ishigami '329. Applicants request withdrawal of the rejection, and the allowance of claims 37, 2-4, and 10.

**Rejection Under 35 U.S.C. §103(a)**

Claims 5-8, 16-19, and 29-32 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Ishigami '329 in view of U.S. Patent No. 5,604,645 to Weaver. The rejection is traversed.

Claims 5, 16, and 29 have been canceled without prejudice. Thus, the rejection is moot as to claims 5, 16, and 29. Applicants request withdrawal of the rejection of claims 5, 16, and 29.

Weaver '645 discloses a mounting bracket 20 for a rear view mirror from which a plurality of rectilinear, hook-like snapping fingers 24 extend. The snapping fingers 24 are used to attach a mirror motor 26 to the mounting bracket 20. The snapping fingers 24 comprise a plurality of circumferentially distributed strap-like cantilever arms each terminating in a hook-like head portion 40 having a lower face 44 adapted to engage a mating lip 30 of the mirror motor 26. The lower face 44 is radially-inwardly directed. The snapping fingers 24 can flex radially outwardly away from the mating lip 30 to enable the mating lip 30 to move past the head portion 40 until the lower face 44 can engage the mating lip 30. The lower face 44 is inclined at an angle of at least about 10°, most preferably between about 10° and about 20°. The snapping fingers 24 are similar in configuration and function to the projecting hooks 48 of Ishigami '329.

The standards for a finding of obviousness must be strictly adhered to. Simply citing one or more prior art references that illustrate different facets of the invention and then concluding that it would be obvious to combine the references to create the applicant's invention is wholly inadequate.

A claimed invention is unpatentable if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art....The ultimate determination of whether an invention would have been obvious under 35 U.S.C. §103(a) is a **legal conclusion based on underlying findings of fact.**<sup>1</sup>

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field....Close adherence to this methodology is especially important in cases where the very ease with which the invention

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<sup>1</sup> The underlying factual inquiries include (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; and (3) the differences between the claimed invention and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966).

can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

Most if not all inventions arise from a combination of old elements....Thus, every element of a claimed invention may often be found in the prior art....However, **identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention....**Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, **there must be some motivation, suggestion or teaching of the desirability of making the specific combination** that was made by the applicant....Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved....In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references....The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art....Whether the Patent Office Examiner relies on an express or an implicit showing, **the Examiner must provide particular findings related thereto....Broad conclusory statements standing alone are not "evidence."**

*In Re Werner Kotzab*, 217 F.3d 1365; 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000)(citations omitted)(emphasis added).

The Examiner asserts that, regarding claims 5 and 29, "Weaver teaches a mounting stud comprising a bulb end, the neck portion having a diameter smaller than the diameter of the bulb end," and references item 40 in Figure 4. Since claims 5 and 29 have been canceled without prejudice, the Examiner's assertions relative to claims 5 and 29 are moot. Nevertheless, item 40 in Figure 4 of Weaver '645 is a generally rectilinear, hook-like projection, virtually identical in configuration and function to the projecting

hooks 48 of Ishigami '329. Item 40 does not constitute a bulb end portion or a neck portion characterized by circularity, as called for in Applicants' claims 5 and 29.

The Examiner also asserts that, with respect to claims 6-8, 16-19, and 30-32, "Weaver teaches wherein the second portion of the mounting stud comprises a neck portion (see portion below taper 44) and a bulb end (see item 40 in Figure 4) the neck end having a smaller diameter than the diameter of the bulb end. Weaver further teaches wherein the bulb end comprises an annular face (see item 42 in Figure 4) having approximately a 45 degree bevel (see column 4, line 15). Weaver also teaches wherein the neck portion comprises a truncated cone inclined approximately 10 degrees (see column 4, line 19)."

Claims 6-8 depend from claim 37. Claims 17 -19 depend from claim 11. Claims 30-32 depend from claim 24. Each of claims 37, 11, and 24, in pertinent part, calls for mounting studs or connectors comprising a neck portion and a bulb end portion having diameters, which indicates that the neck portion and the bulb end portion are characterized by circularity. As discussed above, item 40 is a generally rectilinear, hook-like projection, and cannot constitute a bulb end portion or a neck portion characterized by circularity, as called for in Applicants' claims. Because neither Weaver '645 nor Ishigami '329 discloses mounting studs having the circularity called for in the claims, and thus cannot have a neck portion and a bulb end portion having different diameters, the combination of Weaver '645 with Ishigami '329 cannot reach this limitation of the claims.

Furthermore, the Examiner has failed to identify any legally sufficient motivation, suggestion, or teaching of the desirability of modifying Ishigami '329 to arrive at Applicants' invention. The Examiner asserts that "It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the specific angles and shapes taught by Weaver, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. One would have

been motivated to provide the angles of the bulb end for purpose of creating a secure snap fit connection in order to help guide the insertion of the stud into the aperture, thus providing easier assembly of the components as suggested by Ishigami (see column 2)." However, presumably the inventors of the device disclosed in Ishigami '329 would have determined the optimum configuration of the mating parts for the device disclosed in Ishigami '329, thus eliminating any motivation to modify that configuration through the teachings of Weaver '645, or any other reference. Furthermore, the elements called for in Applicants' claims comprise a bulb end portion and a neck portion characterized by circularity, and the optimal angles and shapes would be different for a circular structure than the rectilinear structures disclosed in Ishigami '329 and Weaver '645. Thus, there would have been no motivation to look to Ishigami '329 or Weaver '645 for optimal angles and shapes relative to the bulb end portion and neck portion of Applicants' claims. The Examiner's rationale for the combination of Ishigami '329 and Weaver '645 is contrived simply to justify the combination, and cannot stand up under close scrutiny. Claims 6-8, 17-19, and 30-32 are patentable over Ishigami '329 in view of Weaver '645.

Applicants request withdrawal of the rejection, and the allowance of claims 6-8, 17-19, and 30-32.

Claims 11-15, 21-28, and 34-36 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Ishigami '329. The rejection is traversed.

The Examiner asserts with respect to claim 11 that "it would have been obvious to one of ordinary skill in the art to use an integrally and rigidly attached snap fit mounting stud to mount the tilt actuator to the mounting frame in the Ishigami mirror. The motivation for doing this would have been to provide lower costs or easier assembly work as is suggested by Ishigami (column 2, line 6)."

The Examiner also asserts with respect to claim 24 that "it would have been obvious to have at least one of a second mounting stud adapted for snap fit communication with the at least one of the second mounting aperture and the first portion



adapted for supporting communication with the tilt actuator assembly. The motivation for doing this would have been to provide lower costs or easier assembly work as suggested by Ishigami (column 2, line 6)."

As discussed above, Ishigami '329 discloses rectilinear, hook-like connectors, not mounting studs having the circularity and diameters called for in claims 11 and 24, and thus, even with the modifications asserted by the Examiner, cannot have a neck portion and a bulb end portion having different diameters. Consequently, whether it would have been obvious to use snap-fit mounting studs and apertures to mount the tilt actuator to the mounting frame in the Ishigami '329 device, the resulting assembly still would not reach the device called for in claims 11 or 24. Thus, claims 11 and 24 are patentable over Ishigami '329.

Claims 12-15 and 21-23 depend from claim 11 and, for the same reasons, are patentable over Ishigami '329. Claims 25-28 and 34-36 depend from claim 24 and, for the same reasons, are patentable over Ishigami '329.

Applicants request withdrawal of the rejection, and the allowance of claims 11-15, 21-28, and 34-36.

Claims 9, 20, and 33 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Ishigami '329 in view of U.S. Patent No. 6,488,382 to Mertens. The rejection is traversed.

Claim 9 depends from claim 37. Claim 20 depends from claim 11. Claim 33 depends from claim 24. Thus, claims 9, 20, and 33 call for the mounting studs or connectors called for in claims 37, 11, or 24.

The Examiner asserts that "Ishigami discloses the mirror assembly as set forth above except lacks teaching a bore extending coaxially through a stud. Mertens teaches a vehicular mirror assembly wherein the stud comprises a bore extending coaxially therethrough (see Figure 4). At the time of the invention, it would have been obvious to

one of ordinary skill in the art to modify the studs of Ishigami to include the bore hole as taught by Mertens. The motivation for doing this would have been to allow a spring to be inserted in the hole to provide elastic tension in the connection as it is suggested by Mertens (see column 2, lines 53-54)." This rationale is entirely without merit, and wholly inadequate to support the rejection.

First, Mertens '382 does not teach a bore extending coaxially through a stud. Mertens '382 teaches a large annular projection comprising a plurality of flexible fingers arranged to couple a carrier to a mirror support. The projection is not a stud; it is part of a connection which appears adapted to enable pivoting of the carrier relative to the mirror support about an axis coaxial with the projection.

Second, there is absolutely no rational reason for including bore holes in the studs of Ishigami '329. The fasteners of Ishigami '329 are generally rectilinear, not cylindrical or columnar. Boreholes would serve no function whatsoever in such structures. The idea of including bore holes in the Ishigami '329 fasteners is ludicrous. Given the fact that the nipping claws provide the resiliency necessary to the operation of the Ishigami '329 fasteners, there is no reason to include boreholes in the projecting hooks. As well, there is no reason to include boreholes in the nipping claws.

Third, there is no reason to insert a spring in the Examiner's asserted borehole. As discussed above, the nipping claws provide the resiliency necessary to the operation of the Ishigami '329 fasteners. Adding springs to boreholes installed in the Ishigami '329 fasteners would contribute nothing to the performance of the fasteners, would complicate the fabrication of the mirror, and would add cost.

Finally, as discussed above, the claims call for mounting studs or connectors having a bulb end portion having a first diameter and a neck portion having a second diameter, wherein the first diameter is greater than the second diameter. The mounting studs and connectors are characterized by circularity. This limitation is not disclosed in

Ishigami '329. It is also not disclosed in Mertens '382. Thus, the combination of Ishigami '329 and Mertens '382 cannot reach the device called for in claims 9, 20, or 33.

Claims 9, 20, and 33 are patentable over Ishigami '329 in view of Mertens '382. Applicants request withdrawal of the rejection, and the allowance of claims 9, 20, and 33.

### CONCLUSION

Applicants submit that all of the claims remaining in the application are allowable over the prior art of record. If there are any outstanding issues which the Examiner feels may be resolved by way of telephone conference, the Examiner is cordially invited to contact the undersigned to resolve these issues. Early notification of allowability is respectfully requested. Applicants request an Advisory Action be issued in this case.

Respectfully submitted,

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